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| APPLICATION NO. 097733,642 | FILING DATE 12/08/00 | FIRST NAMED INVENTOR MICHALIK | ATTORNEY DOCKET NO. A 2384-002128 |
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| EXAMINER BELL, K |
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| ART UNIT 1661 | PAPER NUMBER 6 |
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DATE MAILED: 11/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/733,648

Applicant(s)

MECHALIK

Examiner

KENT L. BELL

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on application filed 12/8/00
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☒ Other: Rule 1.105 Requirement

Detailed Action

Status of Application

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1661.

The photographic illustrations filed October 15, 2001 have been entered and approved by an Official Draftsperson. The illustration filed December 8, 2000 has been canceled.

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of sections (c)-(d) of 37 CFR 1.163 (Section C is modified):

(c)The specification should include the following sections in order:

(5) Variety denomination.

(d) The text of the specification or sections defined in paragraph C of this section, if applicable, should be preceded by a section heading in upper case, without underlining or bold type.

Even though Applicant has set forth in the specification the name of the instant variety, Applicant should include the instant cultivar's "Variety denomination" in a specific subheading as outlined above, i.e. VARIETY DENOMINATION: 'Pensyb'.

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Objections to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

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No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. Applicant recites "The new variety is the result of cross breeding of a group of about 50 seedlings having double dark red flowers via embryo rescue.". The recitation stated above does not disclose the parents of the instant plant. Applicant should set forth in the specification the parents of the instant cultivar and which was used as the pollen parent and which was used as the seed parent. If the parent plants are unnamed plants within a specific breeding group then a simple statement such as --The new variety is the result of a cross between two unnamed selections from breeding group (insert name of breeding group).--. Correction and/or clarification is necessary. The origin of the plant must be clearly and unambiguously set forth.

B. Applicant is requested to set forth in the specification whether the parental cultivars, if known and named have been patented in the United States, is currently the subject of a pending

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U.S. Plant Patent application, or unpatented. If patented, --(U.S. Plant Patent No.)-- should be inserted after the cultivar name. If the subject of a pending application, such should be referred to by serial number. If unpatented, --(unpatented)-- should be inserted after the appropriate cultivar name.

C. Applicant should import into the specification a brief comparison between the instant cultivar and the parental cultivars, if known, such need not be in any great detail, but should at least be to the extent to positively distinguish the respective plants from each other.

D. Page 1, lines 15-19, Applicant should set forth in the specification the age of the plants when described and container size (if grown in a container).

E. Applicant should set forth in the specification the typical and observed plant width or spread.

F. Page 1, line 34, Applicant states leaf base is "Overlapped". In addition to stating that the lobes at the base of the leaf are overlapped, applicant should set forth in the specification a botanical descriptor for the leaf base, i.e. cordate, if accurate.

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G. Page 2, line 2, Applicant states leaf margin is “emarginate”. When compared to the photographic illustration filed October 15, 2001, it appears that the leaf margin is entire. It appears the term “emarginate” is not appropriate in this instance. Correction and/or clarification is necessary.

H. When compared to the photographic illustration filed October 15, 2001 it appears the leaves have a distinct zone. If accurate, Applicant should set forth in the specification the zone coloration. Color designation(s) should be referenced by the employed color chart.

I. Page 2, line 3, Applicant states venation is “Brighter than leaf surface”. Applicant should set forth in the specification the RHS color designation(s) for the venation coloration. The recitation “Brighter than leaf surface” is vague and insufficient in this regard.

J. Page 2, lines 11 and 14, Applicant states petiole and stem/branch color is “Medium green”. Applicant should set forth in the specification the color designation(s) which represents “Medium green” with reference to the employed color chart. The recitations “Medium green” are vague and insufficient in this regard.

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K. Page 2, lines 11 and 12, Applicant should set forth in the specification additional information relative to the instant plant's petioles including the typical and observed petiole diameter, if such information is available.

L. Applicant should set forth in the specification the typical and observed number of inflorescences per plant and flowering season.

M. Page 2, lines 27 and 28, Applicant states "Flowers on umbel; umbel on pedicel; pedicel on peduncle.". This recitation does not appear to be accurate as flowers make up the umbel and flowers are connected to the pedicel, not the umbel connected to the pedicel. It appears applicant meant to say "Umbel; flowers on pedicel; pedicel on peduncle.". Correction and/or clarification is necessary.

N. Applicant should set forth additional information in the specification relative to the instant plant's petals such as the typical and observed margin descriptor. In addition to stating that the petal base is narrow, applicant should set forth in the specification a botanical descriptor for the petal base.

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O. Page 3, lines 12-20, Applicant should set forth additional information in the specification relative to the instant plant's sepals such as the typical and observed quantity and margin descriptor.

P. Page 3, line 26, Applicant sets forth a color designation for the instant plant's petaloids. However, applicant has not specified whether the color designation set forth is for the upper, lower, or both surfaces. Applicant should set forth in the specification which surface is being described, if the color designation set forth is for both surfaces then such should be stated in the specification, if the color designation set forth is for one surface, applicant should set forth which surface is being described and set forth the color designation(s) for the opposite surface.

Q. Page 4, line 1, Applicant should delete "unusual" as this term is vague and meaningless in this instance.

R. Page 4, line 3, Applicant recites "Long-lasting" under the inflorescence subheading. In addition to stating "long-lasting", Applicant should set forth in the specification the lastingness of the individual bloom.

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S. Page 4, line 13, Applicant states there are five pistils per flower. Applicant should review the amount of pistils per flower as there may only be one pistil that is five parted. Correction and/or clarification is necessary.

The above listing may not be complete. Applicants should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Claim Rejection

35 U.S.C. 112, 1st & 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objections to the Disclosure Section above.

35 U.S.C. 102

The claimed Geranium variety 'Pensyb' is described in Breeder's Right application number 980066 filed in the European Community on January 14, 1998 and published on April 15, 1998.

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The claimed Geranium is also described in Breeder's Right application number OO00524 filed in Poland on February 22, 1999 and published on March 31, 1999. The claimed Geranium is also described in Breeder's Right application number 1086 filed in the Czech Republic on August 16, 1999 and published on October 1, 1999. The claimed Geranium is also described in Breeder's Right application number P9802251 filed in Hungary on October 7, 1998. Typically the UPOV member countries publish notice of the Plant Breeder's Right application filing. However, it is unknown to the Examiner when the Hungary application was published. If the cultivar 'Pensyb' was disclosed in this publication and on sale to the public more than one year prior to the effective filing date of the instant application, then the instant application may be a bar under 35 U.S.C. 102. A search of the Internet also revealed a Licencing agreement for 'Pensyb', set forth as its synonym/trade name Red Sybil or Red Sybil Pensyb. However, it is unknown to the Examiner when the Licencing agreement was published but it would appear that the agreement was published in 1999 (attached). The published applications and licencing agreement are "printed publications" under 35 U.S.C. 102 because they are accessible to persons concerned with the art to which the documents relate. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See also MPEP § 2128. For example, UPOV publishes the application number, date of publication, species of plant and variety denomination for PBR certificates, and copies of application 980066 are obtainable through the European Communities Register of Applications for Community Plant Variety Rights. This register is open to public inspection and the

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information in this register is published every two months. Thus information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ 2d 1618, 1620, (Bd. Pat. App. & Inter. 1992)(“The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.”).

While the publications cited above disclose the claimed plant variety, a question remains as to whether the references are enabling. If the plant was publicly available, then the application(s) and/or licensing agreement combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. The ability of the Office to determine whether the claimed plant was publicly available is limited. Search of electronic databases, the internet and the Office’s collection of retail catalogs has not revealed any evidence that the claimed plant was on sale anywhere in the world. However, the Office’s collection of retail

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catalogs is not comprehensive. Furthermore, the claimed plant may have been sold at the wholesale level, sold under a different name, or even distributed to interested parties free of charge. Since the inventor and assignee of the instant application are in a better position to know when, if ever, the claimed plant was made publicly available, the Examiner is requiring this information in the attached Requirement for Information Under 37 CFR 1.105.

This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (703) 306-3224. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205.

The fax phone number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

K. L. Bell

**KENT L. BELL
PATENT EXAMINER**

Kent L. Bell

Detailed Action

REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined reasonably necessary to the examination of this application.

The information is required to determine when, if ever, the claimed plant variety, 'Pensyb', was publicly available prior to the filing date of the instant application.

In response to this requirement please provide any information available regarding the sale or other public distribution of the claimed plant variety anywhere in the world, including the date(s) of any sale or other public distribution. Also, please provide copies of the published applications, 980066, OO00524, 1086, P9802251 (if published), and licencing agreement. The Office does not maintain a collection of Breeders' Rights documents and they are not readily obtainable electronically. Since the inventor of the instant application is listed by UPOV as the breeder of the published applications, it is reasonable to expect that Applicant can readily obtain the requested document(s) and information.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first

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communication responding to this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

Applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is three months.